<u>**REMARKS**</u>

In the Final Office Action, the Examiner rejects claims 1-20 under 35 U.S.C. § 112, second paragraph, as indefinite; and rejects claims 1-20 under 35 U.S.C. § 103(a) as unpatentable over L'HEUREUX et al. (U.S. Patent No. 6,697,942) in view of ENGSTROM et al. (U.S. Patent No. 7,212,808). Applicants respectfully traverse these rejections. Claims 1-20 remain pending in the present application.

<u>Final rejection improper</u>

Applicants respectfully submit that the finality of the Final Office Action is improper. The Final Office Action includes new grounds of rejection that are not necessitated by Applicants' amendments or by the filing of an information disclosure statement (*see* M.P.E.P. § 706.07(a)). For instance, claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite because they recite the term "transmission format." This is a new ground of rejection, because the Examiner did not present this ground of rejection in any previous action. However, these claims have previously recited this term, and have not been amended to recite "transmission format." In fact, independent claim 6, among others, was not amended at all in Applicants' previous response. As such, this new ground of rejection is clearly not necessitated by an amendment by Applicants.

Furthermore, claims 3, 7, 8, 12, and 13 were previously rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over L'HERUREUX et al. The ground of rejection has now changed. However, this new ground of rejection is not necessitated by an amendment by Applicants for one or more of these claims. For instance, claims 7 and 8 were amended in Applicants' last response to change the word "wherein" to "where."

Applicants respectfully submit that changing "wherein" to "where" did not necessitate the new ground of rejection.

Therefore, Applicants respectfully submit that the finality of the Final Office Action is improper. Accordingly, Applicants respectfully request that the Examiner withdraw the finality of the Final Office Action.

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<u>Rejection under 35 U.S.C. § 112, second paragraph</u>

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Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection.

With respect to <u>claims 1-20</u>, the Examiner alleges that it is not clear what defines the term, "transmission format" (Office Action, p. 2). Applicants initially note that claims 18 and 19 do not recite "transmission format." Therefore, this rejection does not apply to these claims.

Moreover, Applicants respectfully submit that this term has sufficient meaning, both under the plain English definition of the term, as well as in the art. "Transmission format" of a message may be properly interpreted as, for example, a format of transmission of the message, or a format by which the message is transmitted. For instance, a transmission format for an e-mail message would be a format by which e-mails are transmitted, a transmission format for an SMS message would be a format by which SMS messages are transmitted, etc. Thus, Applicants respectfully submit that the term "transmission format" is clear.

The Examiner further states that, for the purposes of examination, the Examiner

"assumes the claims refer to the fact that the message may be formatted differently based on the user selection" (*id.*). In other words, the Examiner appears to interpret "transmission format" as "format of a message." Applicants respectfully submit that, for at least the reasons provided above, the Examiner's interpretation is unreasonable.

Further with respect to claims 1-20, the Examiner alleges that it is not clear what defines a "message type" (*id.*). The Examiner states that "Applicant's claims recite that an email with a message is a different type than an email without a message" (*id.*). Applicants respectfully submit that nowhere do the claims recite that an email with a message is a different type than an email without a message, as alleged by the Examiner.

Applicants assume the Examiner is referring to claim 17, which recites, *inter alia*, that the set of message types comprises at least one of an e-mail with attachment, or an e-mail without attachment. Applicants respectfully point out that nowhere in this claim, or any other claim, is it recited that an e-mail with an attachment and an e-mail without an attachment are two <u>different</u> types of messages.

The fact that an e-mail with an attachment and an e-mail without an attachment are each enumerated separately in this dependent claim does not imply that these are different message types. In fact, as set forth in Applicants' arguments with respect to the references, as well as in Applicants' Specification, an e-mail with an attachment and an e-mail without an attachment would be considered the same message type (*see, e.g.,* Applicants' Specification, p. 6, lines 17-19, 24-27). Thus, Applicants respectfully submit that the term "message type" is clear.

The Examiner further states that, for the purposes of examination, the Examiner "assumes any message with different data types could be considered a different type of

message" (Office Action, p. 2.). Therefore, Applicants respectfully submit that, for at least the reasons provided above, the Examiner's interpretation is unreasonable.

Applicants further respectfully submit that the Examiner appears to improperly apply this interpretation of claim 17 to all claims, including those that do not recite these features. Therefore, this rejection is improper as applied to these other claims.

With respect to claims 18-20, the Examiner alleges that it is not clear what is meant by the phrase "a 'message editor' that receives a message" (Office Action, p. 3). The Examiner further states, "[f]or the purposes of examination the examiner assumes the claim recites that the user composes a message in a message editor" (*id*.). Without limiting the scope of these claims to the Examiner's interpretation, Applicants acknowledge that the Examiner's interpretation of this phrase is an example of a possible reasonable interpretation of this phrase. Thus, Applicants respectfully submit that the above phrase is sufficiently clear.

For at least the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over L'HEUREUX et al. in view of ENGSTROM et al. Applicants respectfully traverse this rejection.

Applicants initially note that the Examiner lists claims 1, 2, 4-6, 9-11, 14-16, 18, and 20 stand rejected under 35 U.S.C. § 102(e) as allegedly unpatentable over L'HEUREUX et al. in view of ENGSTROM et al. (Final Office Action, p. 3). A proper

rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention. Any feature not directly taught must be inherently present. *See* M.P.E.P. § 2131. Since the Examiner does not cite a single reference in this rejection, Applicants respectfully submit that this rejection is improper. However, for the purposes of responding to the Final Office Action, Applicants assume that the Examiner intended to reject these claims under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al.

Independent claim 1 is directed to a method of preparing a message in an electronic communication device, the method comprising providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types; detecting, via a control unit of the electronic communication device, a user selection of a particular message type of the plurality of message types; receiving the message in the editor; and changing, via the control unit, a transmission format for the message in dependence of the user selection, where the message is received in advance of the changing the transmission format. L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest one or more of these features.

For example, L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types. The Examiner relies on col. 3, lines 1-30 of L'HEUREUX et al. as allegedly disclosing "a common editor for all the different types of messages" and on col. 5, lines 40-50 of L'HEUREUX

et al. as allegedly disclosing "the user selects the message type" (Final Office Action, p.

3). Applicants respectfully submit that neither this section nor any other section of

L'HEUREUX et al. discloses or suggests the above feature of claim 1.

At col. 3, lines 1-31, L'HEUREUX et al. discloses:

SUMMARY OF THE INVENTION

The present invention describes a data formatting method for embedding
diverse data types in an electronic mail message by forming a network
compliant e-mail message header, generating one or more command
blocks representing diverse data types, and combining the data types with
the message header such that the e-mail message conforms to network
standards. In operation, data are edited on and sent from a first system, for
example, a subscriber service center, by means of a set of custom message
commands. The editing system at the sender's location employs a
Graphical User Interface (GUI) enabling non-sophisticated users to create
complex mixed data type messages. The mixed data type message may
contain commands to reset the configuration of a remote device, for
example to change a password or update a device setting. Additionally,
other segments, or blocks of the message may contain a graphic image
and/or a plain text message. The exact nature of the data depends upon
predefined data types.

At the sender's location the mixed data type message is passed from the
graphical user interface to a command formatter which translates the GUI
output into a custom command format suitable for the receiving apparatus
to interpret. A standard e-mail header is then formed and the two parts of
the message are combined into e-mail format for transmission. Once in the
proper format, the e-mail message may be transferred over standard e-mail
networks using standard e-mail protocols. For example, an e-mail message
may be sent over the Internet to a SMTP server using SMTP/MIME
protocols. From the SMTP server the message is transferred to the
recipient's POP server where it is stored until the recipient downloads it
during an e-mail session.

This section of L'HEUREUX et al. discloses embedding diverse data types into an

electronic mail message. In other words, there is a single message type (*i.e.*, e-mail) into

which different data types (*e.g.*, plain text, graphic image) can be incorporated. This

section of L'HEUREUX et al. does not disclose a common editor for all message types –

this section of L'HEUREUX et al. at best discloses an editor for <u>a single message type</u> (*i.e.*, e-mail).

Moreover, this section of L'HEUREUX et al. does not disclose <u>a set of message types that can be selected by a user</u>, as L'HEUREUX et al. discloses only a single message type. As such, Applicants respectfully submit that L'HEUREUX et al. does not disclose or suggest providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types, as recited in claim 1.

At col. 5, lines 40-54, L'HEUREUX et al. discloses:

> The GUI software 210 provides a non-skilled user with the ability to construct a complex message containing multiple data types by checking boxes, selecting from pop-up menus, painting with conventional bitmap editing tools, and laying out forms with graphical tools, all methods well known to those skilled in the art. Although the GUI software of the present invention is not a requirement for constructing multiple data-type messages, one distinct advantage is its ease of use, accommodating those not skilled in software art. Thus, it is possible to construct a message by "hand" using a common text editor, for example a word processor, but it would be very difficult since the invention utilizes a dynamic security key which must be calculated and further, any graphical image to be embedded would have to be crafted bit by bit using the text editor.

This section of L'HEUREUX et al. discloses that a user can construct a "complex message" containing multiple data types. Nowhere does this section of L'HEUREUX et al. discloses a set of message types that can be selected by a user, let alone the above feature of claim 1. Instead, this section of L'HEUREUX et al. is directed to including multiple data types into an e-mail, which is a single message type (*see, e.g.,* L'HEUREUX et al., col. 1, lines 11-14 ("this invention relates to a technique for processing diverse data within standard electronic mail (e-mail) messages")). Since

L'HEUREUX et al. does not disclose multiple message types, this section of L'HEUREUX et al. cannot be reasonably construed to disclose or suggest providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types, as recited in claim 1.

Moreover, Applicants respectfully submit that L'HEUREUX et al. teaches away from a set of message types that can be selected by a user in an editor common for all message types. L'HEUREUX et al. is directed to "embedding diverse types in an electronic mail message" (L'HEUREUX et al., Abstract) (emphasis added). The above sections of L'HEUREUX et al. elaborate on a method by which different data types are incorporated into a "standard" e-mail. For instance, a "standard e-mail header" is formed, and the "e-mail message [is] transferred over standard e-mail networks using standard e-mail protocols" (L'HEUREUX et al., col. 3, lines 26-29) (emphasis added).

Applicants respectfully submit that to construe L'HEUREUX et al. as disclosing a set of message types, or an editor common for all message types would completely obviate the entirety of L'HEUREUX et al.'s teachings, which are directed to modifying and sending a standard e-mail. As such, Applicants respectfully submit that L'HEUREUX et al. teaches away from providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types of a plurality of message types, as recited in claim 1.

The Examiner further alleges that arguing that L'HEUREUX et al. discloses only a single message type is in direct contrast with Applicants' claim 17, which recites, inter alia, that the set of message types comprises at least one of an e-mail with attachment, or

an e-mail without attachment. As discussed above, nowhere in this claim, or any other

claim, is it recited that an e-mail with an attachment and an e-mail without an attachment

are two different types of messages. In fact, as also discussed above, an e-mail with an

attachment and an e-mail without an attachment would be considered the same message

type (*see, e.g.,* Applicants' Specification, p. 6, lines 17-19, 24-27). As such, Applicants

respectfully submit that L'HEUREUX et al., which is directed solely to e-mail, cannot be

reasonably relied upon as disclosing a plurality of message types, as recited in claim 1.

Applicants respectfully submit that the disclosure of ENGSTROM et al. does not

remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Further with respect to claim 1, the Examiner alleges (Final Office Action, p. 4):

> [t]he terminal inherently comprises input means and display means for the
> purpose of letting the user 'select' any known type of data to be transferred
> (selecting a message type, and detection of a user selection)

Applicants respectfully disagree with the Examiner's allegations. Terminal 110 in

L'HEUREUX et al. corresponds to an editing terminal, such as a desktop computer

(L'HEUREUX et al., col. 4, line 66-col. 5, line 2). L'HEUREUX et al. discloses that

terminal 110 is used to compose e-mail messages that include the diverse data

(L'HEUREUX et al., col. 4, line 66-col. 5, line 2). Clearly, L'HEUREUX et al. does not

disclose or suggest (inherently or otherwise) input means and display means, as the

Examiner alleges, for the purpose of letting a user select a message type.

Furthermore, § 2112 of the M.P.E.P. states (emphasis in original):

> In relying upon the theory of inherency, the examiner must provide a basis
> in fact and/or technical reasoning to reasonably support the determination
> that the allegedly inherent characteristic necessarily flows from the
> teachings of the applied prior art.

Here, the Examiner provides no evidence to support the inherency assertion. Accordingly, the Applicants respectfully submit that Examiner has not met the burden required to establish a proper case of inherency.

Applicants respectfully submit that the disclosure of ENGSTROM et al. does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Furthermore, with respect to claim 1, the Examiner alleges (Final Office Action, p. 3):

> L'Heurux discloses a messaging system (email) for a portable terminal that provides a common interface for different message types (abstract).

Applicants respectfully disagree with the Examiner's allegation that L'HEUREUX et al. discloses a common interface for different message types. As mentioned above, L'HEUREUX et al. is directed to only <u>a single message type</u> (*i.e.*, e-mail), and does not disclose a common interface for <u>different message types</u>.

Applicants respectfully submit that the disclosure of ENGSTROM et al. does not remedy the deficiencies in the disclosure of L'HEUREUX et al. set forth above.

Further still with respect to claim 1, Applicants respectfully submit that the Examiner has not addressed all of the features of claim 1. For instance, Applicants respectfully submit that the Examiner has not alleged that any cited reference discloses or suggests changing, via the control unit, a transmission format for the message in dependence of the user selection, where the message is received in advance of the changing the transmission format, as recited in claim 1.

The Examiner alleges (Final Office Action, p. 4):

> Engstrom discloses a messaging service where the transmission protocol is automatically selected based on the chosen message type. . . .

Applicants respectfully point out that claim 1 does not recite a "transmission protocol," as alleged by the Examiner. Such an allegation does not address any of the actual claimed features recited in claim 1. Therefore, the Applicants respectfully submit that Examiner fails to establish a *prima facie* case of obviousness with respect to claim 1.

For at least the foregoing reasons, Applicants submit that claim 1 is patentable over L'HEUREUX et al. and ENGSTROM et al. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al.

Claims 2-5 and 17 depend from claim 1. Therefore, Applicants submit that these claims are patentable over L'HEUREUX et al. and ENGSTROM et al. for at least the reasons given above with respect to claim 1. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 2-5 and 17 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al.

Independent claim 6 recites features similar to (yet possibly different in scope than) features described above with respect to claim 1. Therefore, Applicants respectfully submits that claim 6 is patentable over L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1. Claims 7-16 depend from claim 6. Therefore, Applicants submit that these claims are patentable over L'HEUREUX et al. and ENGSTROM et al. for at least the reasons given above with respect to claim 6. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 6-16 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al.

Independent <u>claim 18</u> recites features similar to (yet possibly different in scope than) features described above with respect to claim 1. Therefore, Applicants respectfully submits that claim 18 is patentable over L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1. Moreover, claim 18 recites additional features not disclosed or suggested by L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination.

For instance, L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, do not disclose or suggest after receiving the message, displaying, at the display of the communication device, a plurality of selectable candidate message types for the message, as recited in claim 18. The Examiner does not, in any way, appear to even attempt to address this feature of claim 18. Accordingly, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 18. Moreover, this feature is further not disclosed or suggested by L'HEUREUX et al. and ENGSTROM et al., whether taken alone or in any reasonable combination, for at least reasons similar to reasons provided above for features of claim 1.

For at least the foregoing reasons, Applicants submit that claim 18 is patentable over L'HEUREUX et al. and ENGSTROM et al. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 18 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al.

<u>Claims 19 and 20</u> depend from claim 18. Therefore, Applicants submit that these claims are patentable over L'HEUREUX et al. and ENGSTROM et al. for at least

the reasons given above with respect to claim 18. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 19 and 20 under 35 U.S.C. § 103(a) based on L'HEUREUX et al. and ENGSTROM et al.

Conclusion

In view of the foregoing remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such assertions (*e.g.*, whether a reference constitutes prior art, reasons to modify a reference and/or to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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